

REMARKS

Claims 1-36, 40, 41 and 43-81 were pending in the present application. In the above amendments, claims 23-39, 42, 45-50, 60-65, and 71-76 are cancelled. New Claims 82-86 have been added. Therefore, after entry of the above amendments, claims 1-22, 40, 41, 43, 44, 51-59, 66-70 and 77-86 will be pending in this application.

Patentee believes that the present application is now in condition for allowance and prompt and favorable action is respectfully requested.

A. Amendment to the Drawings

The amended figures submitted herewith have been identified as "Amended" in accord with 37 C.F.R. §1.173. The changes to the drawings were explained in detail in the Preliminary Amendment filed on June 14, 2001, and are summarized herein for the Examiner's convenience:

In FIG. 3A, the reference number for MICROPHONE is changed from 254 to 154.

In FIG. 3B, block 214, DE-ENCRYPTION is replaced with DECRYPTION.

In FIG. 4, block 294, DE-ENCRYPTION is replaced with DECRYPTION.

In FIG. 5, block 394, DE-ENCRYPTION is replaced with DECRYPTION.

In FIG. 5, the CDMA RECEIVER reference number is changed from 372 to 392.

In FIG. 6 the PSTN reference number is changed from 10 to 450.

All changes are clerical in nature and do not introduce new subject matter. Accordingly, Patentee submits that the grounds for the objection to the drawings has been removed.

B. Amendment to the Claims

The claims presented herein have been correctly marked in accord with 37 C.F.R. §1.173 such that matter to be omitted is enclosed in brackets and matter to be added is underlined. Support for the amendments and new claims as required under 37 C.F.R. §1.173(c) is shown as follows:

Claim	Status	Support for Changes
Claim 1	Original	No change
Claim 2	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claim 2; claim amended for clarification purposes only; no new matter.
Claim 3	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 3; claim amended to address 35 USC §112 issues ; no new matter.
Claim 4	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 4; claim amended to address 35 USC §112 issues ; no new matter.
Claim 5	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 5; claim amended to address 35 USC §112 issues ; no new matter.
Claim 6	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 6; claim amended to address 35 USC §112 issues ; no new matter.
Claim 7	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 7; claim amended to address 35 USC §112 issues ; no new matter.
Claim 8	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 8; claim amended to address 35 USC §112 issues ; no new matter.
Claim 9	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 1 and 9; claim amended to address 35 USC §112 issues ; no new matter.

Claim	Status	Support for Changes
Claim 10	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claim 10; claim amended for clarification purposes only; no new matter.
Claim 11	Original	No change
Claim 12	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 10 and 12; claim amended to address 35 USC §112 issues ; no new matter.
Claim 13	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 10 and 13; claim amended to address 35 USC §112 issues ; no new matter.
Claim 14	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 10 and 14; claim amended to address 35 USC §112 issues ; no new matter.
Claim 15	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 10 and 15; claim amended to address 35 USC §112 issues ; no new matter.
Claim 16	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner; the claim language has been amendment to more clearly state that Claim 16 is directed to a method, as indicated by dependent claims 17-20.	Original claim 16; claim amended for clarification purposes only; no new matter has been added as all language was previously present in original claim 16.
Claim 17	Original	No change
Claim 18	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 16 and 18; claim amended to address 35 USC §112 issues ; no new matter.
Claim 19	Amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Original claims 16 and 19; claim amended to address 35 USC §112 issues ; no new matter.
Claim 20	Amended herein to address 35 U.S.C. §112 issues	Original claims 16 and 20; claim amended to

Claim	Status	Support for Changes
	noted by the Examiner	address 35 USC §112 issues ; no new matter.
Claim 21	Original	No change
Claim 22	Original	No change
Claims 23 - 39	Cancelled	
Claim 40	New; added by the amendment dated June 14, 2001; amended herein to add "to be processed and routed, the network controller storing therein at least one list of members of at least one push-to-talk (PTT) private network" and "to be processed and routed in accordance with said at least one list"	Column 4 line 59 to Column 5 line 26; Column 6 lines 33-56; Fig. 2
Claims 41-42	Cancelled	
Claim 43	New; added by the amendment dated June 14, 2001	Column 6 lines 33-56
Claim 44	New; added by the amendment dated June 14, 2001; amended herein to replace "users" with "devices of a communication group of wireless devices" and "the communications group comprising a push to talk (PTT) network"; deleted "at least some of said plurality of mobile users being members of a private network"; replaced "the private network" with "other members of the communications group"; added "from any member	Column 4 line 59 to Column 6 line 33; Fig. 2

Claim	Status	Support for Changes
	of the communications group”	
Claims 45-50	Cancelled	
Claim 51	New; added by the amendment dated September 17, 2004; amended herein to replace “private communication network” with “communication group of wireless devices”	Column 4 line 59 to Column 6 line 56; Column 10 lines 5-37; Fig. 2
Claim 52	New; added by the amendment dated September 17, 2004	Column 7 Lines 13-29
Claim 53	New; added by the amendment dated September 17, 2004	Column 5 line 52 to Column 6 line 5
Claim 54	New; added by the amendment dated September 17, 2004; amended herein to correct claim dependency	Column 5 lines 27 to 37; Fig. 2
Claim 55	New; added by the amendment dated September 17, 2004; amended herein to correct claim dependency	Column 5 lines 27 to 37; Column 10 line 39 to Column 11 line 5; Fig. 6
Claim 56	New; added by the amendment dated September 17, 2004	Column 7 Lines 29-46
Claim 57	New; added by the amendment dated September 17, 2004	Column 7 Lines 29-46
Claim 58	New; added by the amendment dated September 17, 2004	Column 6 Lines 57-65
Claim 59	New; added by the amendment dated September 17, 2004; amended herein to correct claim dependency	Column 5 line 63 to Column 6 line 5

Claim	Status	Support for Changes
Claims 60-65	Cancelled	
Claim 66	New; added by the amendment dated September 17, 2004; amended herein to add "between member devices of a PTT group communicating through a public switched telephone network" in the preamble and to replace "data" with "at least one PTT frame and vocoder"	Column 4 line 59 to Column 5 line 26; Column 7 line 53 to Column 8 line 20; Fig. 2
Claim 67	New; added by the amendment dated September 17, 2004	Column 7 Lines 13-29
Claim 68	New; added by the amendment dated September 17, 2004	Column 5 line 63 to Column 6 line 5
Claim 69	New; added by the amendment dated September 17, 2004	Column 7 Lines 29-46
Claim 70	New; added by the amendment dated September 17, 2004; amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Column 6 Lines 57-65
Claims 71-76	Cancelled	
Claim 77	New; added by the amendment dated September 17, 2004; amended herein to replace "data" with "at least one PTT frame and vocoder"	Column 4 line 59 to Column 5 line 26; Column 7 line 53 to Column 8 line 20; Fig. 2
Claim 78	New; added by the amendment dated September 17, 2004	Column 7 Lines 13-29
Claim 79	New; added by the amendment dated September 17, 2004	Column 5 line 63 to Column 6 line 5

Claim	Status	Support for Changes
Claim 80	New; added by the amendment dated September 17, 2004	Column 7 Lines 29-46
Claim 81	New; added by the amendment dated September 17, 2004; amended herein to address 35 U.S.C. §112 issues noted by the Examiner	Column 6 Lines 57-65
Claim 82	Newly added with the present amendment	Column 6 Lines 46-56
Claim 83	Newly added with the present amendment	Column 6 Lines 46-56
Claim 84	Newly added with the present amendment	Column 6 Lines 57-65
Claim 85	Newly added with the present amendment	Column 6 Line 66 to Column 7 Line 12
Claim 86	Newly added with the present amendment	Column 6 Line 66 to Column 7 Line 12

C. Election/Restriction

The Office Action made final the restriction requirement to claims 23-26-45-50, 60-65 and 71-76, which were previously nonelected, and directed the Patentee to cancel the nonelected claims. Accordingly, the Patentee has cancelled the nonelected claims from this reissue application, and hereby reserves the right to refile and pursue the nonelected subject matter in one or more divisional applications.

D. Rejections under 35 U.S.C. §112

The Office Action rejected claims 66-70 under 35 U.S.C. §112 allegedly as failing to comply with the enablement requirement. Patentee respectfully traverses this ground of rejection and requests reconsideration thereof.

The Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). MPEP §2164.04.

Claims 66-70 claim the tangible element of manufacture of a computer readable storage medium. Patentee submit that it is well known to those skilled in the art that the computer implemented methods recited in the claims may be carried out via a computer readable medium such as a medium stored in a computer. Accordingly, Patentee requests withdrawal of the 35 U.S.C. §112 rejection as to claims 66-70.

The Office Action rejected claims 2-20, 54, 55, 59, 66-70, and 77-81 under 35 U.S.C. 112 allegedly as being indefinite. Patentee has amended the claims to address the specific issues raised by the Examiner in the Office Action pages 3-5. Claim 16 has also been amended to clarify that the invention claimed therein is for a method for facilitating private communication among a plurality of eligible member user telephone sets in a private communication network system. Accordingly, it is submitted that this ground of rejection has been overcome.

E. Rejections under 35 U.S.C. § 101

The Office Action rejected claims 66-70 and 77-81 under 35 U.S.C. §101 allegedly as being directed to non-statutory subject matter. Patentee respectfully traverses this ground of rejection and requests reconsideration thereof.

With regard to the rejection of claims 66-70, Patentee has amended these claims to be directed to a “computer readable medium.” Patentee directs the Examiner to *Ex parte Bo Li*,

Appeal 2008-1213 (BPAI 2008), which cites the PTO's agreement that "It has been the practice for a number of years that a 'Beauregard Claim' of this nature be considered statutory at the USPTO as a product claim. (MPEP §2105.01, I)." Patentee respectfully submits that claims 66-70 recite statutory subject matter and request that this ground of rejection be withdrawn.

With regard to the rejection of claims 77-81, the Patentee has amended these claims to positively recite a "PTT communication network." Patentee submits that the "PTT communication network" is a specific "machine" that qualifies as statutory subject matter under 35 U.S.C. §101. Accordingly, Patentee respectfully submits that claims 77-81 recite statutory subject matter and requests withdrawal of this ground of rejection.

F. Rejections under 35 U.S.C. §102(e)

The Office Action rejected claims 40, 44, 51-53, 59, 66-68, and 77-79 under 35 U.S.C. §102(e) allegedly as being anticipated by Kay et al. (U.S. Pat. No. 5,475,689) ("Kay"). Patentee respectfully traverses this ground of rejection and requests reconsideration thereof.

Anticipation is an exacting standard. Under 35 U.S.C. §102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Implicit in a review of an examiner's anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. See, e.g., *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) ("To properly compare [an allegedly anticipatory prior art reference] with the claims at issue, we must construe the term 'computer' to ascertain its scope and meaning.").¹

¹ More recently, the Court of Appeals for the Federal Circuit has stated: To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation. *Celeritas Techs. v. Rockwell Int'l Corp.*, 150

Kay is generally directed to a cellular system that includes a local area network where nodes on the network include various base switching controllers. Specifically, the Examiner has cited passages that describe a reverse allocation request including a temporary mobile ID that identifies the reverse allocation request as having come from the originator of the dispatch setup message. The reverse assignment identifies a particular voice channel (see Kay col. 7, lines 41-55).

As amended, claim 40 now recites:

a network controller operative to cause data packets transmitted within the wireless communication system *to be processed and routed, the network controller storing therein at least one list of members of at least one push-to-talk (PTT) private network*; and
 a push-to-talk PTT controller operative to cause process and route push-to-talk PTT requests and private network data packets to be processed and routed in accordance with said at least one list.

(emphasis added). The passages cited from Kay do not disclose a network controller that stores at least one list of members of at least one push-to-talk (PTT) private network and a PTT controller operative to cause PTT requests and private network data packets to be processed and routed in accordance with the at least one list. Therefore, as Kay does not disclose or suggest at least this feature of claim 40, this ground of rejection should be withdrawn.

Regarding claim 44, Patentee has amended the claim to recite “means for receiving a request from any member of the communications group, the request for a point-to-multipoint transmission to the communications group” and “means for directing the point-to-multipoint data packets exclusively from a current active member of the communications group to other members

F.3d 1354, 1361 (Fed. Cir. 1998). But disclosure of each element is not quite enough – this court has long held that “[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as

of the communications group in response to the request” (emphasis added). The Examiner has cited passages that generally describe dispatch transactions that can be point to multipoint, but the passages do not disclose receiving a request for a point-to-multipoint transmission from any member of the communications group, and directing the point-to-multipoint data packets exclusively from a current active member, as now recited in the claim. Therefore, as Kay does not disclose or suggest at least this feature of claim 44, this ground of rejection should be withdrawn.

Regarding claim 51, the Examiner contends that Kay discloses an interface to a public switched telephone network and for receiving interleaved vocoder frames and PTT frames from a first member user, citing Figure 1, Figure 2. col. 3 lines 44-49, and col. 7 lines 41-45 of Kay. Patentee respectfully disagrees. Kay col. 3 lines 44-49 discloses that a dispatch initiator may operate from a station connected to the PSTN. Kay col. 7 lines 41-45 discloses that the dispatch initiator initiates a voice transaction by operating a push-to-talk (PTT) switch, and that an initial event is the transmission of a reverse allocation request on the ECC. These passages do not disclose “an interface to a public switched telephone network and for receiving *interleaved vocoder frames and PTT frames* from a first member user” (emphasis added). Those skilled in the art will understand that interleaving may comprise transmission of data from two or more sources over a single path. Nowhere do the cited passages disclose the interleaving of vocoder and PTT frames as recited in claim 51. Therefore, as Kay does not disclose or suggest at least this feature of claim 51, this ground of rejection should be withdrawn.

Regarding claims 66 and 77, the Examiner contends that Kay discloses receiving at least one PTT frame and vocoder frames from a member of a PTT communication network through a

in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 175 Ct. Cl. 644 (Ct. Cl. 1966) (emphasis added)).

public switched telephone network (referring to Figures 1 and 5); granting a speaker privilege to the member in response to a PTT request contained within the at least one PTT frame (referring to Figure 5); establishing at least one forward communication link with the at least two other members of the PTT communication network (referring to col. 2, line 57); and providing the data frames from the member to the at least two other members of the PTT communication network through the at least one forward communication link (referring to col. 7, lines 54-55). Patentee respectfully disagrees.

As noted above, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. Kay discloses the adding of a plurality of BSCs that are interconnected by a local area network referred to as a Traffic Interconnect Local area network (TIL) (see column 2 lines 1-6). Figure 5, cited by the Examiner in rejecting claims 66 and 77, illustrates a message transaction sequence carried out between a mobile station (MS), a channel access processor (CAP) an associated SIM and a TIL. Thus the system of Kay depends on the inclusion of BSCs interconnected by a local area network. Claim 66, on the other hand, recites “receiving at least one PTT frame and vocoder frames from a member of a PTT group through a the public switched telephone network” (emphasis added). Referring to Figure 1 of Patentee’s specification, it can be seen that the disclosed functionalities are effectuated by a network call manager in communication with the PSTN rather than the mobile devices and their associated base stations and MSCs. Patentee has clarified the distinctions by amending claim 66 to recite that the method is for “enabling push-to-talk (PTT) communications between member devices of a PTT group communicating through a public switched telephone network.” Similar amendments have been made to claim 77. Therefore, as Kay does not disclose or suggest at least these features of claims 66 and 77, this ground of rejection should be withdrawn.

For at least the above reasons, Patentee submits that Kay does not disclose independent claims 40, 44, 51, 66, and 77 and that these claims are allowable. Patentee further submits that dependent claims 43, 52-59, 67-70, and 78-81 are allowable at least by virtue of their dependency on an allowable base claim.

G. Rejections under 35 USC §103

Claim 41 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kay in view of Fleischer et al. (U.S. Pat. No. 5,680,446). Patentee traverses this ground of rejection and requests reconsideration thereof.

Fleischer et al. fails to cure the deficiencies of Kay. Fleischer et al. generally discloses a network screening application that provides two screening features for a private telecommunications network, but fails to disclose or suggest a network controller that stores at least one list of members of at least one push-to-talk (PTT) private network and a PTT controller operative to cause PTT requests and private network data packets to be processed and routed in accordance with the at least one list. Since the combination of Kay and Fleischer et al. fails to disclose all of the elements of the independent claim, dependent claim 41 cannot be rendered obvious by the cited combination per MPEP §2143.03. Patentee respectfully requests reconsideration and withdrawal of the 35 USC §103 rejection as to claim 41.

Claims 43, 58, 70, and 81 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Grube et al. (U.S. Pat. No. 5,387,905). Patentee traverses this ground of rejection and requests reconsideration thereof.

Grube et al. fails to cure the deficiencies of Kay. Grube et al. generally discloses processing of dispatch calls in a multi-site communication system wherein a request for a

dispatch call is routed to a controller which assigns a controlled device to support the request. However, Grube et al. but fails to disclose or suggest a network controller that stores at least one list of members of at least one push-to-talk (PTT) private network and a PTT controller operative to cause PTT requests and private network data packets to be processed and routed in accordance with the at least one list. Grube et al. also fails to disclose or suggest interleaved vocoder frames and PTT frames and an interface to a public switched telephone network and for receiving interleaved vocoder frames and PTT frames from a first member user. Grube et al. also fails to disclose receiving at least one PTT frame and vocoder frames from a member of a PTT group through the public switched telephone network. Since the combination of Kay and Grube et al. fails to disclose all of the elements of the independent claims, dependent claims 43, 58, 70, and 81 cannot be rendered obvious by the cited combination per MPEP §2143.03. Patentee respectfully requests reconsideration and withdrawal of the 35 USC §103 rejection as to claims 43, 58, 70, and 81.

Claim 54 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kay in view of Danne et al. (U.S. Pat. No. 5,761,619). Patentee traverses this ground of rejection and requests reconsideration thereof.

Danne et al. fails to cure the deficiencies of Kay. Danne et al. generally discloses a cellular telecommunications system with a plurality of nodes, but fails to disclose or suggest interleaved vocoder frames and PTT frames and an interface to a public switched telephone network and for receiving interleaved vocoder frames and PTT frames from a first member user. Since the combination of Kay and Danne et al. fails to disclose all of the elements of the independent claim, dependent claim 54 cannot be rendered obvious by the cited combination per MPEP §2143.03. Patentee respectfully requests reconsideration and withdrawal of the 35 USC §103 rejection as to claim 54.

Claim 55 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Weiss (U.S. Pat. No. 5,151,922). Patentee traverses this ground of rejection and requests reconsideration thereof.

Weiss fails to cure the deficiencies of Kay. Weiss generally discloses controlling a speaker mute time to transmit an information message from a first communication device to a second communication device, but fails to disclose or suggest interleaved vocoder frames and PTT frames and an interface to a public switched telephone network and for receiving interleaved vocoder frames and PTT frames from a first member user. Since the combination of Kay and Weiss fails to disclose all of the elements of the independent claim, dependent claim 55 cannot be rendered obvious by the cited combination per MPEP §2143.03. Patentee respectfully requests reconsideration and withdrawal of the 35 USC §103 rejection as to claim 55.

Claims 56-57, 69, and 80 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Glaser (U.S. Pat. No 6,072,463). Patentee traverses this ground of rejection and requests reconsideration thereof.

Glaser fails to cure the deficiencies of Kay. Glaser generally discloses processing of dispatch calls in a multi-site communication system wherein a request for a dispatch call is routed to a controller which assigns a controlled device to support the request. However, Glaser but fails to disclose or suggest interleaved vocoder frames and PTT frames and an interface to a public switched telephone network and for receiving interleaved vocoder frames and PTT frames from a first member user. Glaser also fails to disclose receiving at least one PTT frame and vocoder frames from a member of a PTT group through the public switched telephone network. Since the combination of Kay and Glaser fails to disclose all of the elements of the independent claims, dependent claims 56-57, 69, and 80 cannot be rendered obvious by the cited combination

per MPEP §2143.03. Patentee respectfully requests reconsideration and withdrawal of the 35 USC §103 rejection as to claims 56-57, 69, and 80.

H. Allowable Subject Matter

Patentee thanks the Examiner for allowing claims 1 and 21-22. The Examiner states that claims 2-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112, 2nd paragraph stated in the Office Action. Patentee requests confirmation that the Examiner is referring to claims 2-22, as claims 23-30 were previously withdrawn via restriction. As detailed above, Patentee believe that the outstanding 35 U.S.C. §112, 2nd paragraph issues have been addressed and respectfully request allowance of claims 2-23.

Conclusion

In light of the amendments contained herein, Patentee submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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